

REMARKS

Applicants respectfully request reconsideration of the above-captioned application. Claims 28-59 are currently pending.

Claims 28-59 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Joao et al (U.S. Patent No. 5,903,830) in view of Vizcaino (U.S. Patent No. 5,317,636).

Applicant's respectfully request that the Examiner address the arguments presented regarding the Joao et al. patent from the previous Office Action. Merely changing a 35 U.S.C. §102(e) rejection using a first reference to a new rejection under 35 U.S.C. §103(a) using the first reference in combination with a second reference does not alleviate the Examiner of the duty to address the Applicants' arguments regarding the claim features not taught, but are alleged to be in the first reference in the new 35 U.S.C. §103(a) rejection. The Examiner is requested to make a detailed response as required under MPEP §707.07.

The Joao et al. patent is directed to a transaction security apparatus and method which, as explained for instance at column 2, is designed to provide for obtaining an authorization from and/or providing notice to a card holder before, during and/or shortly after a transaction. Specifically, as identified at column 5, lines 21-22, the apparatus is utilized to provide "card holder authorization." A central processing computer processes information and data pertinent to a transaction and to a particular card account. If transaction parameters meet certain criteria, the central processing computer transmits a signal and/or data to a cardholder's communication device and thereafter waits for the cardholder to respond to the transmission in order to authorize or decline the transaction. See column 5, lines 40-

43, column 6, lines 9-11 and column 6, lines 44 and 45. If the cardholder does not respond within a prescribed time, the central processing unit may transmit limited authorization indicating that the cardholder did not necessarily authorize the transaction. However, if the central processing computer identifies the cardholder reply as being one to authorize the transaction, then the central processing computer may transmit a signal to the point of sale terminal to notify the point of sale terminal that the transaction has been authorized and approved. See column 7, lines 29-34.

As identified at column 7, beginning at line 45, the cardholder's communication device "may be programmed so as to receive and/or to analyze the transaction information and/or data and reply or respond to same automatically and/or with preset or programmed replies and/or responses". The cardholder's communication device is said to be programmed "to limit and/or restrict the amounts and/or types of transactions", etc. as articulated at column 7, lines 49 et seq.

The entire purpose of the Joao et al. system is to provide "authorization, notification and/or security in conjunction with credit card" pertaining to a financial transaction and/or wireless communication device authorization. Column 1, lines 8-16.

A. Prima Facie case of Obviousness not made in the Office Action.

1. All of the elements of the claims are not disclosed or suggested by the applied prior art.

Completely lacking from the Joao et al patent with respect to the present claims is any sense or suggestion of "associating *the limited-use credit card number* with a *customer account number* and a set of conditions" as recited, among other things, in claim 28, the sole independent claim. The Office cites column 17, lines 37-

67, and column 18, lines 1-54, column 7, lines 45-64 and column 5, lines 20-67 of the Joao et al. patent as disclosing the claimed feature.

However, a review of column 17, lines 37-67, and column 18, lines 1-54, column 7, lines 45-64 and column 5, lines 20-67 cited in the Office Action shows no disclosure or suggestion of a limited use credit card number being associated with a customer account number and a set of conditions. Instead, only the customer's credit card number and a set of conditions are associated with a transaction, not a separate, limited-use credit card number as recited in the claims.

The Office admits that the Joao et al. patent fails to explicitly teach detecting in a computer system a transaction using the limited-use credit card number and processing the transaction in accordance with the set of conditions associated with the limited-use credit card number. The Office alleges that the Vizcaino patent overcomes this deficiency of the Joao et al. patent.

The Office cites the abstract and column 3-6 lines 1-76 of the Viscaino patent as disclosing the claimed feature. However, as stated in the background section of Applicants' specification, the Vizcaino patent is directed to a "smart" card and does not involve a limited use credit feature. The cited pages of the Viscaino patent disclose as stated by the Examiner on pages 2 and 3 of the Office Action, a method of presenting a smart card, such as the card shown in Figure 1 of the Viscaino patent, to a merchant. Referring to Figure 1 of the Viscaino patent, a verification number is displayed in the window 32 of the card 20. Also prominently displayed on the front of the card is the account number 24 of the cardholder, John Q. Public. After the merchant inputs the account number 24 and it is confirmed as being valid, the verification number is requested (see Figure 6, blocks 124, 126 and 130). The

verification number displayed in window 32 is transmitted to the authorization computer and used to generate a transaction sequence number (TSN). In the authorization computer, the generated TSN is compared to the stored TSN. If the TSNs match, the transaction is authorized.

It appears the Office is equating the verification number disclosed in the Vizcaino patent with the claimed limited-use credit card number. However, the verification number is merely an encrypted code that is decoded by the authorization computer. This is analogous to the present transaction practice of the merchant asking potential purchasers for their ZIP code, when authorizing a transaction. In addition, the verification number must be used in combination with the cardholder's account number on the front of the smart card. Among the exemplary advantages of the present invention is that the user's actual credit card number is not exposed to potential interception as being transmitted over networks or by unscrupulous employees of merchants. In stark contrast, the Vizcaino patent discloses providing the potentially unscrupulous employee or the unsecured network with the user's account number or actual credit card number as a first step in making a transaction.

The claimed limited-used credit card is capable of being used by itself when a customer makes a purchase, the verification number of the Vizcaino patent is useless without the cardholder account number also being provided at the time of purchase. The verification number of the Vizcaino patent is not a limited-use credit card number as claimed in the instant application.

Therefore, the Vizcaino patent does not disclose or suggest a limited-use credit card number or associating in the computer system the limited-use credit card

number with a customer account number and a set of conditions as recited in claims 28-59.

In addition to the lack of disclosure regarding the above recitations of claim 28, it is respectfully submitted that many of the dependent claims add recitations which further remove the present invention from the applied art. For instance, there would be no reason to allocate additional limited-use credit card numbers (particularly since they don't exist in the applied art) upon a customer request and/or event trigger with only one credit card number and allocating additional credit card numbers, particularly limited-use credit card numbers, as recited in claim 29, for instance. This is also particularly true of claim 30, where the event triggers identified as the use of a preset amount or number of limited use credit card numbers and the associated implication to the initial allocation of these sometimes one-use credit card numbers has been depleted and needs to be refreshed.

Additionally, it would be counter to the purposes of the Joao et al. patent to deactivate this credit card number based on the limited-use event. Instead, the credit card of the Joao et al. patent would not be deactivated upon a set of conditions associated with a limited-use credit card number being met or a limited-use event. With respect to claim 32, again there is no reason to be associating another limited-use credit card number in response to a deactivating event or allocating it to the customer account number insofar as two separate numbers are not part of the Joao et al system. With respect to claim 33, there would of course be no reason to maintain a queue of available limited use credit card numbers or assigning the limited use credit card numbers from the queue. In addition, the cited portion of the Joao et al. patent refers to limiting transactions, not maintaining a list of available

limited-use credit card numbers or to assigning the limited-use credit card numbers.

As for claims 34 and 35, the cited section of the Joao et al. patent refers to the cardholder communication device receiving authorization information, not a limited-use credit card number. Applicants note that there are other distinctions in the dependent claims which additionally further remove the present invention from the applied art but will not belabor the point for sake of brevity.

Neither the Joao et al. patent nor the Vizcaino patent disclose or suggest all of the features recited in the claims individually, or in combination.

For at least the above reasons, claims 28-59 are allowable over the applied prior art.

2. No suggestion or motivation to combine the applied references.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Office Action does not identify any identify any suggestion or motivation to combine or modify the systems of the Joao et al. patent with the smart card disclosed in the Vizcaino patent other than the Applicant's own claim language. Nor does the Office Action provide any explanation as to how the alleged limited-use credit card number disclosed in the Joao et al. patent would be substituted for,

modified, or otherwise combined with the verification number disclosed in the Vizcaino patent. Therefore, the obviousness rejection cannot be maintained.

B. Conclusion

In summary, applicants respectfully submit that the applied art neither discloses nor suggests the subject matter of claims 28-59 which include, *inter alia*, associating the limited use credit card number with the customer number and a set of conditions, within the context of that claim. The references, also, do not provide any suggestion or motivation to combine the respective teachings.

In light of the foregoing, applicants respectfully request reconsideration and allowance in the above-captioned application.

Should any questions arise in connection with this application, or should the Examiner believe a telephone conference would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL PC

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By: 
Martin E. Miller
Registration No. 56,022

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620